

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MUNEYOSHI SATO,
HIDEO KOBAYASHI, MINORU ISHIGURO
and HIDEO YOSHIDA

Appeal No. 1997-0903
Application 08/266,865¹

ON BRIEF

Before HAIRSTON, JERRY SMITH and FLEMING, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

¹ Application for patent filed July 05, 1994. According to Appellants, this application is a continuation of 07/958,189, filed October 09, 1992, now abandoned.

Appeal No. 97-0903
Application No. 08/266,865

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-3, which constitute all the claims in the application.

The disclosed invention pertains to a camera for recording optically readable print size information within the exposed area of a frame of film. A light-emitting display module is used to expose the film to time and/or date information as well as panoramic print information.

Representative claim 1 is reproduced as follows:

1. A camera, equipped with an exposure date recording feature for recording print size information on a film to be optically read by a photographic printer having a zoom lens so as to automatically change a focal length of the zoom lens based on the print size information and permit different sizes of pictures to be made from a regular size frame and simultaneously conceal portions of the regular size frame based on said print size information if said print size information contains panoramic size information so as to make a panoramic size print from said regular size frame, said camera comprising:

a camera body provided with subject exposure means for optically exposing a subject to a frame of film disposed in said camera body;

a light-emitting display module, including a first pair of light-emitting elements, a second pair of light-emitting elements and a third pair of light-emitting elements built in said camera body, for displaying at least one of date information, representing a date of exposure of the frame of

Appeal No. 97-0903
Application No. 08/266,865

said film, and time information, representing a time of exposure of the frame of said film, and exposing the information displayed thereon to a frame of said film when exposing the subject to said frame of said film through said subject exposure means; and

print information set means, provided on said camera body and operable from outside of said camera body, for (a) causing said light-emitting display module to display, as panoramic print information, a specific code including alphabetical characters when said print information set means is operated so that at least one of said first pair of light-emitting elements displays at least one of said alphabetical characters, (b) allowing said light-emitting display module to display numerals as the information displayed thereon, and (c) exposing said print information on at least one of the portions of said frame so that said print information appears as a visible image on said frame when said film is developed and is optically read by the photographic printer.

The examiner relies on the following references:

Hattori	4,330,186	May 18, 1982
Lapeyre	4,705,372	Nov. 10, 1987
Taniguchi et al. (Taniguchi '201)	4,862,201	Aug. 29, 1989
Itabashi	5,003,329	Mar. 26, 1991
Hata et al. (Hata)	5,057,857	Oct. 15, 1991
Taniguchi et al. (Taniguchi '006)	5,060,006	Oct. 22, 1991

Claims 1-3 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Taniguchi '201 in combination with Hattori, Lapeyre, Itabashi, Hata and Taniguchi '006.

Rather than repeat the arguments of appellants or the

Appeal No. 97-0903
Application No. 08/266,865

examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication

Appeal No. 97-0903
Application No. 08/266,865

appellants have made no separate arguments with respect to any of the dependent claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley

Appeal No. 97-0903
Application No. 08/266,865

Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.),
cert. denied, 488 U.S.

825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories,
Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985),
cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v.
Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933
(Fed. Cir. 1984). These showings by the examiner are an

essential part of complying with the burden of presenting a
prima facie case of obviousness. Note In re Oetiker, 977 F.2d
1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to representative, independent claim 1,
the examiner cites Taniguchi '201 as teaching the conventional
practice to record data on a frame of film such that a printer
prints the image according to the instructions indicated by
the data [answer, page 3]. Taniguchi '006 and Hata were also
cited as evidence of coding the film to control a printer
[id., page 5]. The examiner cites Itabashi, Lapeyre and
Hattori as teaching that it was known to use light-emitting
diodes to generate data for recordation on the film. The
examiner asserts that the invention of claim 1 would have

resulted from an obvious combination of the teachings of the six cited references.

Appellants argue that the "causing" and "exposing" limitations recited in the last paragraph of claim 1 are missing from all of the patents relied on by the examiner, and therefore, there is no teaching or suggestion of the "print information set means" as recited in claim 1 [brief, page 6].

We note that the references cited by the examiner basically fall into one of two groups of teachings. Taniguchi '201, Taniguchi '006 and Hata all teach the concept of placing a code on a frame of film to direct a printer how to print the exposed film. Taniguchi '201 places a reference mark (12) outside the exposed portion of the film frame [Figure 9]. Taniguchi '006 places a plurality of marks (CO_1 , CO_2 , CO_3 , etc.) outside the exposed portion of the film frame [Figure 14]. Hata places a reference mark (38a) outside the exposed portion of the film frame [Figure 10]. Thus, each of these three references teaches the placement of a machine-readable code outside the exposed area of the film frame.

Hattori, Lapeyre and Itabashi all teach the concept of exposing information to be printed on an exposed portion of

the film frame. The Hattori data is alphanumeric and provides information about the picture useful to the user. The Lapeyre data is similar in this respect. Hata teaches the use of a light-emitting diode to expose a portion of a film frame to include various kinds of information that might be useful to the user. Thus, each of these three references is directed to exposing human-readable information onto an exposed film frame. None of the three references teaches or suggests that the information recorded on the film is machine readable so that anything can be controlled as a result of the information.

When the collective teachings of these six references are considered, the artisan is informed that human-readable codes can be exposed onto the film frame to provide information useful to the user, and machine-readable panoramic codes can be placed outside the exposed area of the film frame to control printing of the exposed film. Claim 1 recites that the machine-readable panoramic information is exposed onto a portion of the film which is visible on the developed film.

The cited prior art does not teach or suggest, nor is it apparent to us, why the artisan would have found it obvious to place machine-readable panoramic code information in the visible area of the developed film frame. Appellants are able to permit this because the subsequent printing operation will remove the machine-readable code from the visible part of the print. Absent appellants' disclosure of the subsequent printing operation, there would be no motivation to expose the panoramic code data onto a visible portion of the exposed film frame.

Although the examiner argues that the printing aspects of appellants' system form no part of the claimed invention, the examiner has not addressed why the artisan would have been motivated to expose panoramic print information as a visible image on the frame of film. This operation must occur at the camera and is clearly recited in claim 1.

The examiner's approach is basically to dismiss the claimed invention as being obvious without providing a factual record which supports this position. The examiner cites case law for the proposition that he does not have to find every

Appeal No. 97-0903
Application No. 08/266,865

little detail of the claimed invention. The examiner must recognize that when the "little" details become the focus of patentability, the examiner's position must be supported by an appropriate factual record or by a reasoned analysis which clearly supports the obviousness of the argued differences. Neither the supporting factual record nor the reasoned analysis is present in this case.

In summary, we have not sustained the examiner's rejection of independent claim 1 or of dependent claims 2 and 3 which stand or fall therewith. Accordingly, the decision of the examiner rejecting claims 1-3 is reversed.

Appeal No. 97-0903
Application No. 08/266,865

REVERSED

Kenneth W. Hairston)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Michael R. Fleming)	
Administrative Patent Judge)	

JS/dm

Martin Fleit, P.A.
Evenson, McKrown, Edwards & Lenahan, P.L.L.C.
Suite 700
1200 G Street, N.W.
Washington, D.C. 20005-3814

Appeal No. 97-0903
Application No. 08/266,865